

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert M. Levin
Serial No.: 10/787,486
Filed: February 24, 2004
For: Sesquip™

October 22, 2008
Group Art Unit 3711
Examiner: Dolores R. Collins

Mail Stop APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

ATTENTION: Board of Patent Appeals and Interferences

APPELLANT'S BRIEF (37 C.F.R. 41.37)

This brief is in furtherance of applicant's second Notice of Appeal, filed in this case on July 22, 2008.

The fees required under 37 C.F.R. 41.20(b)(2) were paid on February 13, 2007.

This brief contains these items under the following headings, and in the order set forth below (37 C.F.R. 41.37(c)(1)):

- I REAL PARTY INTEREST
 - II RELATED APPEALS AND INTERFERENCES
 - III STATUS OF CLAIMS
 - IV STATUS OF AMENDMENTS
 - V SUMMARY OF THE CLAIMED SUBJECT MATTER
 - VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
 - VII ARGUMENTS
- ARGUMENT: VIIA REJECTIONS UNDER 35 U.S.C. 112,
FIRST PARAGRAPH

ARGUMENT: VIIB REJECTIONS UNDER 35 U.S.C. 112,
SECOND PARAGRAPH

ARGUMENT: VIIC REJECTIONS UNDER 35 U.S.C. 102

ARGUMENT: VIID REJECTIONS UNDER 35 U.S.C. 103

ARGUMENT: VIIE REJECTIONS OTHER THAN 35 U.S.C. 102,
103 AND 112

VIII CLAIMS APPENDIX

IX EVIDENCE APPENDIX

X RELATED PROCEEDINGS APPENDIX

The final page of this brief bears the practitioner's signature.

I REAL PARTY IN INTEREST (37 C.F.R. 41.37(c)(1)(i))

The real party in interest in this appeal is Robert M. Levin.

II RELATED APPEALS AND INTERFERENCES (37 C.F.R. 41.37(c)(1)(ii))

There are no other appeals or interferences that will directly affect, or be directly affected by, or have a bearing on the Board's decision in this appeal.

III STATUS OF CLAIMS (37 C.F.R. 41.37(c)(1)(iii))

The status of the claims in this application are:

A. TOTAL NUMBER OF CLAIMS IN APPLICATION

The claims in the application as filed are: Claims 1 and 3.

B. STATUS OF THE CLAIMS

1. Claims canceled: Claim 2.
2. Claims withdrawn from appeal: None
3. Claims pending: Claims 1 and 3.
4. Claims allowed: None.
5. Claims rejected: Claims 1 and 3.
6. Claims objected to: None.

C. CLAIMS ON APPEAL

The claims on appeal are: Claims 1 and 3.

IV STATUS OF AMENDMENTS (37 C.F.R. 41.37(c)(1)(iv))

By action dated April 22, 2008, applicant's claims 1 and 3 were rejected. The claims having been finally rejected, applicant filed this appeal on July 22, 2008.

V SUMMARY OF THE CLAIMED SUBJECT MATTER (37 C.F.R. 41.37(c)(1)(v))

The following summary correlates claim elements to specific embodiments described in the application specification, but does not in any manner limit claim interpretation. Rather, the following summary in claim chart form of claims 1 and 3, which rise and fall separately, is provided only to facilitate the Board's understanding of the subject matter of this appeal.

Claim 1 of the application:

An educational method for increasing a student's vocabulary comprising the steps of:

identifying a first expression consisting of a commonly known person, place, thing, event, title, phrase, or quote consisting of one or more words;

obscuring said words by substituting one or more of said words with lesser known words to form a second expression;

Specification p. 2, line 22" "The present invention is a vocabulary building method..."

Specification p. 3, lines 3-5: ..."a common title, name, thing or phrase such as "All Dogs Go To Heaven"... is identified by the person constructing the puzzle.

Specification p. 3, lines 4-5: The first expression is translated by the person constructing the puzzle "using words that may not be common to the student (e.g., Curs are supernally fated in every case)." Specification p. 4, lines 2-3: The ... "sesquipedalian (word or string of not commonly known complex words)" forms the second expression.

presenting the second expression to a student to decipher using his vocabulary knowledge of said lesser known words;

providing said student with one or more definitions of the lesser known words which definitions serve as clues for deciphering the second expression back into the first expression

Specification p. 3, lines 4-5: "The student(s) are presented with a common title, name, thing, or phrase such as 'All Dogs Go To Heaven' using words that may not be common to the student (e.g., Curs are Supernally fated in every case)." (Underlining added).

See also specification p. 3, lines 4-5: The student uses his vocabulary to decipher the common phrase, name, thing or title (e.g., Curs are Supernally fated in every case)." Also see Fig. 1, refs. 5, 9 and 13 for examples of other second expressions to decipher: Undaunted pneuma (5); Cephalic dyad (9) and During the caloric effect of the vesper (13). (Underlining added.)

Specification p. 3, lines 6-8: "...the student is presented with a number of clues, each of which provides the definition of one or more of the unknown words." Also see Specification p. 4, lines 9-10: "With each vocabulary building exercise is a series of clues 7, 11, & 15 which can be used to assist the student in deciphering the sesquipedalian." For example, the clues to decipher "Undaunted pneuma" are ref. 7 Clue #1 undaunted means courageous and resolute; brave. If the movie title BRAVE HEART does not come to mind, an additional clue may be added; Clue # 2 pneuma means the soul; spirit.

whereby said student learns the lesser known words and adds them to his vocabulary by actively using said definitions of the lesser words in deciphering the second expression back into the first expression.

Specification p. 4, lines 19-21: "After studying the clue, the student again attempts to decipher the sesquipedalian. If he or she is successful, the student has increased his or her vocabulary..."

Claim 3 of the application:

The method of claim 1 further comprising the steps of:

providing a means for scoring the number of clues used by the student in deciphering the second expression back into the first expression.

Specification p. 4, lines 13-25 describes the means for scoring depending on the number of clues used by the student. Also see Fig. 1: If no clues are needed, the student scores 16, 3 bonus points for each clue not used. If the student needs only one clue, he scores 13. If he needs both clues but deciphers the puzzle back into the first expression, he scores 10. If he cannot solve the puzzle, he scores 0.

VI GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL (37 C.F.R. 41.37(c)(1)(vi))

Whether claims 1 and 3 are unpatentable over U.S. patent No. 3,678,602 to Alam in view of U.S. patent No. 3,935,651 to Mankoff et al. under 35 U.S.C. 103(a).

VIIA ARGUMENTS-REJECTIONS UNDER 35 U.S.C. 112, FIRST PARAGRAPH (35 C.F.R. 41.37(c)(1)(vii))

The claims on appeal were not rejected under 35 U.S.C. 112, first paragraph, hence there are no issues under this heading.

VIIB ARGUMENTS-REJECTIONS UNDER 35 U.S.C. 112, SECOND PARAGRAPH (37 C.F.R 41.37(c)(1)(vii))

The claims on appeal were not rejected under 35 U.S.C. 112, second paragraph, hence there are no issues on appeal under this heading.

VIIC ARGUMENTS-REJECTIONS UNDER 35 U.S.C. 102 (37 C.F.R. 41.37(c)(1)(vii))

The claims on appeal were not rejected under 35 U.S.C. 102, hence there are no issues under this heading.

VIID ARGUMENTS-REJECTIONS UNDER 35 U.S.C. 103 (37 C.F.R. 41.37(c)(1)(vii))

According to the United States Supreme Court in the case of *KSR Int'l v. Teleflex, Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007), a hallmark of invention is that the claimed combination results in a new function. In particular, the Supreme Court emphasized that "the principles laid down in *Graham* reaffirmed the 'functional approach' of *Hotchkiss*, 11 How. 248." *KSR*, 127 S.Ct. at 1739, 82 USPQ2d at 1395 (citing *Graham v. John Deere Co.*, 383 U.S. 1, 12, 148 USPQ 459, 464 (1966)).

The present invention relates to a vocabulary building method applying what educators call active learning. More particularly, the present invention is an educational method for increasing a student's vocabulary by presenting interactive clues which reveal the meaning of words not known by the student, which information is then used by the student to decipher an expression containing unknown words into an expression that the student knows (the new function).

More particularly, claim 1 involves four steps:

- (1) Identifying a first expression: e.g., *Tiger Woods*.
- (2) Obscuring the words of the first expression by substituting one or more of the words with lesser known words to form a second expression: *Person whose sobriquet is in reference to a fasciated felid and whose cognomen alludes to silvas*.
- (3) Presenting the second expression to a student to decipher based on his or her existing vocabulary.
- (4) Providing the student with one or more definitions of the lesser known words to serve as clues for deciphering the second expression back into the first expression:

Clue #1 *Silva...the forests of an area*

#2 *Felid...a wild or domestic cat*

Fasciated...characterized by broad stripes

#3 *Sobriquet...an affectionate nickname*

Whereby the student learns the lesser known words and adds them to his vocabulary by actively using the definitions of the lesser known words in deciphering the second expression back into the first expression.

Claim 3 involves a further step of providing a means for scoring the number of clues used by the student in deciphering the second expression back into the first expression. Using the TIGER WOODS example as set out above, if the puzzle taker can solve the puzzle without any clues based on his own vocabulary, he scores 16 points (10 for solving the puzzle and an extra 3 points for each clue that he did not use). If he uses one clue (e.g., Silva...the forests of an area), he scores 13. If he needs the second clue

also (e.g., Felid...a wild or domestic cat; fasciated...characterized by broad stripes), he scores 10. If he cannot solve the puzzle after he receives the third clue (e.g., sobriquet...an affectionate nickname), he scores zero.

Word flash cards are old, the new function in applicant's method is that, in addition to being given a definition, the student has the immediate opportunity to use the words in deciphering the second expression back into the first expression. This is active learning. The definitions of "silva, fasciated felid and sobriquet" are much more likely to be remembered if the knowledge is immediately used to solve a problem. Use of the definitions to solve a problem is a new function that is not taught or suggested by the cited references, nor is it a function that can be arrived at by the application of "common sense" from the cited references or the general state of the art other than by using applicant's own disclosure as the template. For that reason under the law as expressed by the Supreme Court in KSR, it is believed that applicant's claims are patentable.

A discussion of the references follows:

103(a) Rejection Based on Alam

U.S. patent No. 3,678,602 to Alam discloses a game with three decks of cards. The first deck has a word prefix printed on the front side of the card and the meaning of the prefix on the back. The second deck is similarly constructed with root words on the front and definitions on the back and the third deck has word suffixes on the front and definitions on the back.

Fig.1

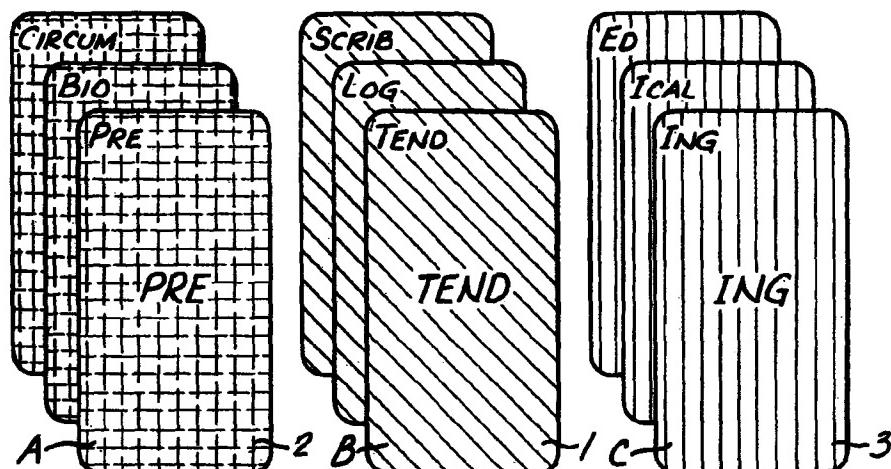
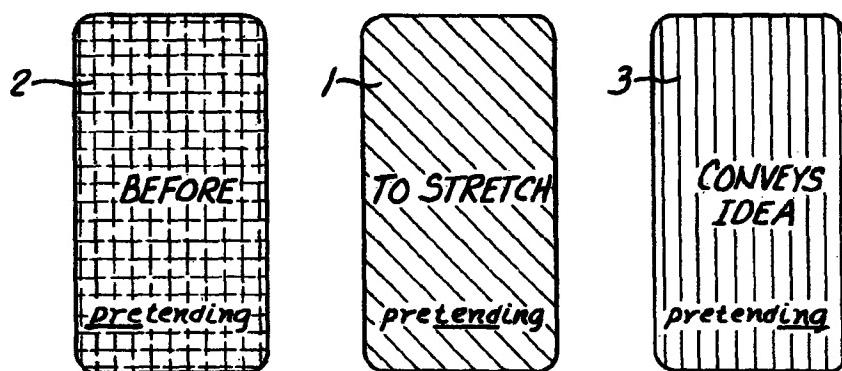


Fig.2



As shown in Alam's Figs. 1 and 2, the word "pretending" is displayed across the front side of three cards ("pre-tend-ing"), using a card from each of the three decks to form the lesser known word (i.e., the first expression). The derivation of the word is provided on the back side of the three cards - namely, "before, to stretch, conveys idea" (i.e., a second expression). The part of the word being defined is also underlined on the back side of each of the three cards, e.g., "before" pretending, "to stretch" pretending and "conveys idea" pretending but no other information is provided.

Applying Alam's teaching to applicant's claim 1 in claim chart form:

An educational method for increasing a student's vocabulary comprising the steps of:

identifying a first expression consisting of a commonly known person, place, thing, event, title, phrase, or quote consisting of one or more words;

obscuring said words by substituting one or more of said words with lesser known words to form a second expression;

Alam provides an educational method for increasing a student's vocabulary.

Alam identifies a first expression such as "pretending" for interpretation formed of three cards, one with "pre" on its face, one with "tend" and the third with "ing" lying face up in that order.

By flipping over the "pre" card, the prefix is defined as "before," but the lesser known word "pretending" appears on the back side of "pre" along with "before." While a second expression "before, to stretch, conveys idea" may be formed by flipping over all three cards, the lesser known word "pretending" is not obscured but appears on all three cards.

presenting the second expression to a student to decipher using his vocabulary knowledge of said lesser known words;

providing said student with one or more definitions of the lesser known words which definitions serve as clues for deciphering the second expression back into the first expression

whereby said student learns the lesser known words and adds them to his vocabulary by actively using said definitions of the lesser words in deciphering the second expression back into the first expression.

Continuing Alam's example with "pretending." If the second expression "before, to stretch, conveys idea" is presented to the student, nothing is left for the student to decipher because the lesser known word "pretending" appears on each of the three cards making up the second expression.

While Alam provides clues there is nothing for the student to decipher. For example, if the "pre" card is turned over but the "tend" and "ing" cards are left face up, the student will learn that "pre" means "before" but the lesser known word "pretending" also appears with "before."

Alam's student may learn the lesser known word "pretending" by memorizing the meaning of the prefix, root and suffix making up the word but not by the active learning process required by applicant's claim 1.

Claim 3 of the application:

The method of claim 1 further comprising
the steps of:

providing a means for scoring the number
of clues used by the student in
deciphering the second expression back
into the first expression.

Alam provides no means as disclosed by
applicant for scoring the number of clues
used to solve the puzzle.

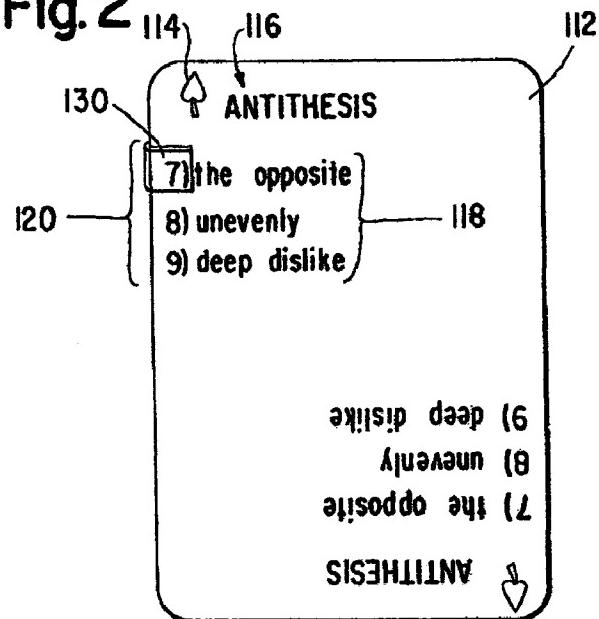
Applicant's method (claim 1) involves four steps: selection of a first expression, construction of a second expression, presentation of the second expression to the student and use of definitional clues to aid the student in deciphering the first expression. Alam's cards simply have a first expression (pretending) and a second expression ("before, to stretch, conveys idea"). There are no added clues to aid in the learning process because the first expression is given with each component of the second expression.

Claim 3 involves a fifth step - namely providing a means for scoring the number of clues used by the student in deciphering the second expression using less common words back into the first expression. Because Alam has no added clues (i.e., the definition of the prefix, etc. is given with the lesser known word), there are no clues to score.

103(a) Rejection Based on Mankoff et al.

U.S. patent No. 3,935,651 to Mankoff et al. discloses a deck of cards with four suits (spades, hearts, diamonds and clubs.) Fig. 2 is representative of Mankoff et al.'s game where the face value of the card is determined by matching a word (e.g., ANTITHESIS) with its meaning (7 the opposite) selected from three choices. Hence the card is the 7 of spades. If the deck has 52 cards, there is a potential for learning 52 lesser known words. The deck is then used in a usual manner to play cards.

Fig. 2



Applying Mankoff et al.'s teachings to applicant's claim 1 in claim chart form:

Claim 1 of the application:

An educational method for increasing a student's vocabulary comprising the steps of:

identifying a first expression consisting of a commonly known person, place, thing, event, title, phrase, or quote consisting of one or more words;

obscuring said words by substituting one or more of said words with lesser known words to form a second expression;

Mankoff et al. provides an educational method for increasing a student's vocabulary.

On each card in the deck, Mankoff et al. identifies an expression such as "antithesis."

Assuming that "antithesis" is the lesser known word (the second expression consistent with applicant's numbering system), Mankoff et al. provides three first expressions, only one of which is correct:

- "7) the opposite
- 8) unevenly
- 9) deep dislike."

In applicant's game, lesser known words are substituted for the words of the first expression and the second expression correctly correlates with the first expression.

presenting the second expression to a student to decipher using his vocabulary knowledge of said lesser known words;

providing said student with one or more definitions of the lesser known words which definitions serve as clues for deciphering the second expression back into the first expression

whereby said student learns the lesser known words and adds them to his vocabulary by actively using said definitions of the lesser words in deciphering the second expression back into the first expression.

In Mankoff et al., the first expression "7) the opposite" is presented with two incorrect first expressions - namely, "8) unevenly" and "9) deep dislike."

Mankoff et al. provides three possible first expressions for the lesser known word "antithesis." Two of the definitions are wrong. Whereas each definitional clue is valid in applicant's method and helps the student interpret the lesser known word. In Mankoff et al., the student must either look "antithesis" up in a dictionary or be told by another player whether he is right or wrong when he selects from multiple choice "7, 8 or 9."

Mankoff et al.'s student may learn the lesser known word "antithesis" by either looking it up in a dictionary or having his selection of multiple choice "7, 8 or 9" confirmed by another player who already knows the word.

Claim 3 of the application:

The method of claim 1 further comprising
the steps of:

providing a means for scoring the number
of clues used by the student in
deciphering the second expression back
into the first expression.

Mankoff et al. provides no means as
disclosed by applicant for scoring the
number of clues used to solve the puzzle.

Use of Mankoff et al.'s card merely involves memorization. As stated above, applicant's method claim 1 involves four steps: selection of a first expression, construction of a second expression, presentation of the second expression to the student and use of definition clues to help the student decipher the first expression. Mankoff et al.'s cards have a first expression (ANTITHESIS) and a second expression (the opposite). The other choices on Mankoff et al.'s cards are wrong answers and there are no added clue definitions to give the student an opportunity to use the word and become actively involved. Whereas in applicant's method the clues with the definitions allow the student to unlock the puzzle and enhance the value of the game as a mental exercise while learning vocabulary.

Applicant's claim 3 involves a further step of providing a means for scoring the number of clues used by the student in deciphering the second expression back into the first expression.

Examiner's Rationale

The examiner's rationale for combining Alam with Mankoff et al. is as follows: Alam teaches a vocabulary building exercise using words (see abstract and claim 1), identifying a first expression (before) obscuring it (card face down) and presenting a lesser-known word to form a second expression (pre) and a means for scoring in the form of a scoring system (col. 4, lines 63-67). Alam fails to explicitly teach providing one or more definitions of the lesser known word(s). Mankoff discloses Vocabulary Playing Cards. Mankoff teaches vocabulary building cards with words and definitions, which are used to decipher the vocabulary word (see abstract, claim 1 and col. 2, lines 29-68). It would have been obvious to modify Alam in view of Mankoff to provide multiple choices for players.

Following the examiner's line of reasoning, if (pre) is the lesser known word, and if Alam is modified like Mankoff et al. to provide a multiple choice of possible meanings on the backside of the card, for example,

1. before
2. after
3. between,

the student has nothing to decipher as the word "pretending" appears on the backside of Alam's card. To remove the word "pretending" from the backside of Alam's card is a reconstruction that would defeat Alam's purpose.

The hypothetical reconstruction of Alam in view of Mankoff et al. proposed by the examiner does not arrive at applicant's four-step process. Hence whether or not it would be obvious to modify Alam in view of Mankoff is irrelevant.

To summarize, applicant's four-step process results in a new function that is not taught or suggested by the cited references, nor is it a function that can be arrived at by the application of "common sense" from the cited references or the general state of the art other than by using applicant's own disclosure as the template. A legal basis for the rejection under section 103(a) has therefore not been made.

VII E ARGUMENTS-REJECTIONS OTHER THAN 35 U.S.C. 102, 103 AND 112 (37 C.F.R. 41.37(c)(1)(vii))

There are no issues other than under 35 U.S.C 103(a).

VIII CLAIMS APPENDIX (37 C.F.R. 41.37(c)(1)(viii))

The text of the claims involved in the appeal are:

1. An educational method for increasing a student's vocabulary comprising the steps of:

identifying a first expression consisting of a commonly known person, place, thing, event, title, phrase, or quote consisting of one or more words;

obscuring said words by substituting one or more of said words with lesser known words to form a second expression;

presenting the second expression to a student to decipher using his vocabulary knowledge of said lesser known words;

providing said student with one or more definitions of the lesser known words which definitions serve as clues for deciphering the second expression back into the first expression

whereby said student learns the lesser known words and adds them to his vocabulary by actively using said definitions of the lesser known words in deciphering the second expression back into the first expression.

3. The method of claim 1 further comprising the steps of:

providing a means for scoring the number of clues used by the student in deciphering the second expression back into the first expression.

IX EVIDENCE APPENDIX

The following is submitted as evidence of commercial success:

Applicant's educational method is sold under the trademark SESQUIP and is carried by a number of newspapers. The column has been favorably reviewed:

"SEQUIP will be an instant classic. It is a challenging word game that is deserving of the company of the crossword." JIM TALENT, former U.S. Congressman and Chair of U.S. House Small Business Committee.

"If you master SESQUIP you could talk and write like William F. Buckley Jr., the man who knows and uses every word in the dictionary..." MARTIN DUGGAN, Producer and host of "Donnybrook" KETC (PBS) TV, St. Louis, Missouri.

X RELATED PROCEEDINGS APPENDIX

There are no related proceedings.

There are no further materials, that are necessary or desirable, required in consideration of this appeal. Accordingly withdrawal of the rejections is respectfully requested.

Respectfully submitted,

/Grace J. Fishel/

Grace J. Fishel (Reg. No. 25,864)
2200 West Port Plaza Drive, Suite 202
St. Louis, MO 63146
Telephone: (314) 878-0440
Fax: (314) 275-7693
Email: fishel@theapplicant.com

CERTIFICATE OF TRANSMISSION

I hereby certify that this correspondence is being electronically transmitted to the Patent and Trademark Office by EFS-Web on October 22, 2008.

/Grace J. Fishel/
Grace J. Fishel